In the

United States Court of Appeals

For the Seventh Circuit

No. 9991

THE DAVISON CHEMICAL CORPORATION, *Plaintiff-Appellant,* *vs.* JOLIET CHEMICALS, INC., DES PLAINES OIL COMPANY, JOLIET CHEMICALS, LTD., and KENNETH F. NASH, *Defendants-Appellees.*	Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

PETITION FOR REHEARING.

The opinion of this Court sounds the death knell for all chemical process patents.

In substance the Court holds that the test of invention is to be applied only to the means by which the underlying principle in a patent for a chemical process is brought into play. The artisan is to be given the benefit of the inventor's analysis of the defects in existing processes and his discovery of the scientific principles which control their solution. If the artisan can then be expected to devise the process of the patent in suit, the patent is invalid.

No patent for a chemical process can meet this test. Such patents have to do with the creation of new compounds or improved processes for the creation of existing compounds or changes in the physical properties of compounds previously known. Once the basic scientific principle is ascertained and clearly stated, all else is obvious.

As an illustration we may take the prior patent to Patrick relied upon in this case as an anticipation. Prior to Patrick an excess of acid was used in the manufacture of silica gel in order to prevent premature setting. It was then necessary to remove the excess acid by dialysis.

Patrick analyzed the defects in the existing process. He discovered that agitation would prevent the premature setting of the mixture. Any skilled worker in the field could devise means of agitation to carry out Patrick's discovery. In fact the specific means that might be used are so obvious that Patrick described them in his specifications by the general term "stirring".

Assume that an inventor discovers that a chemical process may be expedited by the use of a catalyst. What is there left in the way of invention to implement such a discovery? Any trained chemist would know how to introduce a catalyst into a manufacturing process.

This is equally true of the case at bar or any other case in which an inventor discovers that control of temperature at a particular stage of a process will improve the result. There could be no invention in the means of providing the temperature.

All of the leading cases on process patents in the Supreme Court can be reduced to the discovery of a "principle of nature". After the "principle" has been taught any one skilled in the art could have developed the means.

Mowry v. *Whitney*, 14 Wall (81 U. S.) 620: The tan-

gential injection of molten metal into a mould gives it a rotary motion and causes the dross to be thrown to the center of the casting.

Tilghman v. *Proctor,* 102 U. S. 707: Hot water and pressure will separate fat acids and glycerine from animal fat.

Providence Rubber Co. v. *Goodyear,* 9 Wall (76 U. S.) 788: India rubber can be cured by subjecting it to a high degree of artificial heat.

Carnegie Steel Co. v. *Cambria Iron Co.,* 185 U. S. 403: Substantial uniformity from a plurality of blast furnaces can be maintained by using a common dominant pool.

In the *Cambria* case the Court held that it was a part of the essential nature of a process patent that: "The directions and specifications of such a patent are addressed to those skilled in the art. It professes to disclose a method of procedure, not the particular instrumentality that may be employed." (185 U. S. at p. 441.)

Robinson in describing the essential nature of an art or process stresses the unimportance of means:

> "It is so far abstract that it is capable of contemplation by the mind apart from any one of the specific instruments by which it is performed." I Robinson, Patents § 159.

Invention may be largely in the discovery of the source of trouble. From that point the solution may be fairly obvious as in *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.,* 261 U. S. 45, 68:

> "The invention was not the mere use of a high or substantial pitch to remedy a known source of trouble. It was the discovery of the source not before known and the application of the remedy for which Eibel was entitled to be rewarded in his patent."

And afterward, to-wit, on the second day of March, 1950, there was filed in the office of the Clerk of this Court an answer to the petition for rehearing, which said answer is in the words and figures following, to-wit:

In the

United States Court of Appeals

For the Seventh Circuit

No. 9991

THE HAVEGON CHEMICAL CORPORATION, a corporation, *Plaintiff,* vs. JULIET CHEMICALS, INC., a corporation, et al., *Defendants.*	Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

REPLY TO PETITION FOR REHEARING.

JULES L. STRAUS,
JOHN REX ALLEN,
Attorneys for Defendants-Appellees.

U. S. C.
FILED
MAR
KENNETH J.

In the

United States Court of Appeals

For the Seventh Circuit

No. 9991

THE DAVISON CHEMICAL CORPORATION, a corporation, *Plaintiff,* vs. JOLIET CHEMICALS, INC., a corporation, et al., *Defendants.*	Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

REPLY TO PETITION FOR REHEARING.

The petition for rehearing dramatically starts off with the completely unfounded statement that the opinion of this Court "sounds the death knell for all chemical process patents."

In alleged support of such statement the petition mentions a number of Supreme Court cases which it is apparently claimed would have been decided differently if the principle of law laid down in the case of *Funk Bros. Seed Co.* v. *Kalo Inoculant Co.*, 333 U. S. 127 and in the Court's opinion in the present case had been followed. It is interesting to note that only one of these Supreme Court cases dealt with a process that would properly be termed "chemical." That case was *Tilghman* v. *Proctor*, 102 U. S. 707, 26 L. Ed. 288 and of the patent involved the Court said:

"Let us apply these principles to the present case. *In the first place, the claim of the patent is not for a mere principle.* The chemical principle or scientific fact upon which it is founded is, that the elements of neutral fat require to be severally united with an atomic equivalent of water in order to separate from each other and become free. *This chemical fact was not discovered by Tilghman.* He only claims to have invented a particular mode of bringing about the desired chemical union between the fatty elements and water." (Italics ours.)

These and the other cases mentioned in the petition for rehearing are likewise not pertinent because each involved a *new* step or an *unobvious changed* step or element. The last case mentioned, *Copeman Laboratories Co.* v. *General Plastics Corporation,* 149 F. 2d 962 involved a rather limited claim to an ice cube tray of a certain size and formed of non-metallic, easily distortable, self-supporting material to which ice does not readily adhere. We are unable to find anything in the opinion which indicates that the patentee claimed to be the discoverer of any law or principle of nature.

It is clear that the decision of this Court is entirely sound and in accordance with the established, applicable law laid down by the Supreme Court and other Federal Courts.

Respectfully submitted,

JULES L. BRADY,
JOHN REX ALLEN,
Attorneys for Defendants-Appellees.

And afterward to-wit, on the seventh day of March, 1950, the following further proceedings were had and entered of record, to-wit:

UNITED STATES COURT OF APPEALS

For the Seventh Circuit,

Chicago 10, Illinois.

March 7, 1950.

Before:

Hon. J. Earl Major, Chief Judge.
Hon. Philip J. Finnegan, Circuit Judge.
Hon. Walter C. Lindley, Circuit Judge.

The Davison Chemical Corporation, *Plaintiff-Appellant,* vs. Joliet Chemicals, Inc., Des Plaines Oil Company, Joliet Chemicals, Ltd., and Kenneth F. Nash, *Defendants-Appellees.*	Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

9991

It is ordered by the Court that the petition for rehearing of this cause be, and the same is hereby denied.

And afterward, to-wit, on the fifteenth day of March, 1950, the mandate of this Court issued to the United States District Court for the Northern District of Illinois, Eastern Division.

UNITED STATES COURT OF APPEALS

For the Seventh Circuit,

Chicago 10, Illinois.

I, Kenneth J. Carrick, Clerk of the United States Court of Appeals for the Seventh Circuit, do hereby certify that the foregoing printed pages contain a true copy of papers filed and proceedings had, excepting motions and orders relating to filing of briefs and briefs of counsel, in:

Cause No. 9991.

The Davison Chemical Corporation,
Plaintiff-Appellant,

vs.

Joliet Chemicals, Inc., *et al.*,
Defendants-Appellees,

as the same remains upon the files and records of the United States Court of Appeals for the Seventh Circuit.

In Testimony Whereof I hereunto subscribe my name and affix the seal of said United States Court of Appeals for the Seventh Circuit, at the City of Chicago, this 23rd day of May, A. D. 1950.

(Seal)

Kenneth J. Carrick,
Clerk of the United States Court of Appeals for the Seventh Circuit.

FILED
JUN 2 1950
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1949.

No. [redacted]105

THE DAVISON CHEMICAL CORPORATION,
Petitioner,

vs.

JOLIET CHEMICALS, INC., DES PLAINES OIL COMPANY, JOLIET CHEMICALS, LTD., AND KENNETH F. NASH,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

HAROLD W. NORMAN,
Attorney for Petitioner.

THE BUNTHORP-WARREN PRINTING COMPANY, 310 WEST JACKSON, CHICAGO

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Sec. 1254 of Title 28, United States Code 5

IN THE

Supreme Court of the United States

OCTOBER TERM, 1949.

No. .....

THE DAVISON CHEMICAL CORPORATION,
Petitioner,

vs.

JOLIET CHEMICALS, INC., DES PLAINES OIL COMPANY, JOLIET CHEMICALS, LTD., AND KENNETH F. NASH,
Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

To the Honorable the Supreme Court of the United States:

Petitioner prays for a writ of certiorari to the United States Court of Appeals for the Seventh Circuit to review a final judgment of that Court affirming the dismissal of a suit for patent infringement by summary judgment.

Summary Statement of Matter Involved:

Plaintiff brought suit to enjoin the infringement of United States Letters Patent 1,900,859, referred to herein as the Connolly patent, for a process for the manufacture of silica gels. The District Court entered a summary judgment dismissing the suit and holding the patent invalid for

want of invention in view of a prior patent 1,297,724, referred to herein as the Patrick patent (R. 54). The Court of Appeals for the Seventh Circuit found that the Connolly patent was not anticipated by Patrick but that it was void as the mere application of a law of nature and affirmed the judgment of the District Court (R. 64, 68).

The Question Presented:

Can there be a valid patent for a process? Every process embodies a scientific principle or law of nature and the means of applying that principle or law. Is the principle or law to be separated from the inventive concept and the invention tested solely by the ingenuity involved in the means of application? If so, all process patents must fail, because the principle can always be so expressed as to leave the means obvious to those skilled in the field.

The Patent:

Silica gel is an artificial product, not found in nature. It is a hard, transparent substance with ultra microscopic pores. Because of its ability to adsorb moisture from the air, it is used extensively as a dessicant (R. 51). For certain uses it is important that the pores be very small, for other uses larger pores are desired (R. 44). Four distinct grades of the product are specified by the Army and Navy with rigid specifications for each grade (R. 51, 52). If the pores are too small or too large the gel will not meet these specifications (R. 46). Prior to Connolly, all silica gels were ununiform, the pores were too fine and the product was unsatisfactory for use (R. 45, 46). Connolly's patent produced the first commercially usable product.

The manufacture of silica gel is a complicated chemical process in which sodium silicate is mixed with an acid under violent agitation. The resulting product is allowed to set

and is then broken into small pieces, washed for 36 to 48 hours to free it from acid and salt, and dried at a specified temperature (R. 31, 37).

Connolly discovered that the temperature of the wash water could be used to control the density or the size of the pores of the silica gel. The Court of Appeals concedes that this discovery was original with Connolly. It enabled him to convert failure into success. The patent is therefore pioneer in character.

Theory of the Court of Appeals:

The Court of Appeals conceded that Connolly was the first to discover that the size of the pores could be controlled by the temperature of the water used to wash the gel after it had set. In effect, that Court held that this discovery was no part of the inventive concept and that all scientific principles or laws of nature are in the public domain even though as yet unknown to man. The Court thus tested the patent after first endowing some other skilled scientist with knowledge of Connolly's basic discovery. It then found that, endowed with such knowledge, this skilled scientist would have had no difficulty in evolving the process of the patent. Under such a testing formula invalidity was inevitable.

Reasons for Allowance of Writ:

1. The case is of fundamental importance in the law of patents. The effect of the decision of the Court of Appeals is to deny the validity of any patent for a chemical process and if the argument of the Court is carried to its logical conclusion, to deny the validity of any process patent and most, if not all, product and mechanical patents.

2. The decision of the Circuit Court of Appeals is inconsistent with the decisions of this Court in *Eibel Process*

Co. v. *Minnesota & Ontario Paper Co.*, 261 U. S. 45; *Tilghman* v. *Proctor*, 102 U. S. 707; *Providence Rubber Co.* v. *Goodyear*, 9 Wall. 788; *Carnegie Steel Co.* v. *Cambria Iron Co.*, 185 U. S. 403; *McClurg* v. *Kingsland*, 1 How. 202; and *Mowry* v. *Whitney*, 14 Wall. 620. In each of these cases the heart of the invention lay in the discovery of a scientific principle or law of nature. After that discovery was disclosed the application to the patented process was obvious.

3. The decision of the Court of Appeals for the Seventh Circuit is contrary to the decisions of the Courts of Appeals for the Second and Ninth Circuits.

Schering Corp. v. *Gilbert*, 153 F. 2d 428 (C. A. 2).
Vitamin Technologists v. *Wisconsin Alumni Research Foundation*, 146 F. 2d 941, 949 (C. A. 9).

Prayer:

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued to the Court of Appeals for the Seventh Circuit to the end that this cause may be reviewed and determined by this Court, that the judgment of the Court of Appeals for the Seventh Circuit be reversed, and that petitioner be granted such other and further relief as may be proper.

Respectfully submitted,

THE DAVISON CHEMICAL CORPORATION,
By HAROLD W. NORMAN,
Its Attorney.

BRIEF IN SUPPORT OF PETITION.

THE OPINIONS OF THE COURTS BELOW.

The District Court did not render an opinion. The reasons for its decision are stated in its orders found at pages 54 and 55 of the record. The opinion of the Circuit Court of Appeals appears at page 64 of the record; it is reported at 179 F. 2d 793.

JURISDICTION.

The Court has jurisdiction to issue the writ of certiorari requested under Sec. 1254 of Title 28 of the United States Code. The judgment of the United States Circuit Court of Appeals to review which the writ is requested was entered February 8, 1950. A petition for rehearing was duly filed and that petition was denied March 7, 1950.

STATEMENT OF THE CASE.

The petition for the writ of certiorari contains a summary of the material facts necessary to an understanding of the reasons relied upon for the allowance of the writ as well as a statement of the questions involved in the case.

SPECIFICATION OF ERRORS.

1. The Court of Appeals erred in holding the Connolly patent invalid.

2. The Court of Appeals erred in holding that the invention of a process is to be tested after assuming that all scientific principles or laws of nature involved in the invention are known to the public.

SUMMARY OF ARGUMENT.

1. The case is of fundamental importance in the law of patents.

2. The decision of the Court of Appeals is inconsistent with decisions of this Court.

3. The decision of the Court of Appeals is in conflict with the decisions of other Courts of Appeals.

ARGUMENT.

I.

The Case Is of Fundamental Importance in the Law of Patents.

The effect of the decision of the Court of Appeals is to deny the validity of any patent for a chemical process, and, if the argument of the Court is carried to its logical conclusion, to deny the validity of any process or product patent and of most, if not all, mechanical patents. Every chemical reaction, every combination of chemicals, and every modification of a chemical by heat, pressure, electrolysis, dilution, concentration, or atomic bombardment is predicated upon a scientific principle or law of nature. When that principle is fully explained to a skilled worker in the field, including advice as to the step in the process at which the principle is to be applied, the application of the principle requires no inventive genius. Thus, if the test of invention of a process is to be applied, as the Court of Appeals holds, only to the means there can be no valid patent for a process.

This theory of the Court of Appeals is clearly stated:

> "What the skilled scientist, having been fully informed of the newly discovered scientific fact, would have done, would amount only to the exercise of ordinary skill in his profession. Knowing that the porosity and density of the gel varies directly in relation to the temperature of the rinsing water, was it invention for Connolly to apply the law of nature as he did?" (R. 66).

The importance of the role which the discovery of a scientific principle or law of nature plays in a patent was

recognized by this Court when it granted a writ of certiorari to review the decision of this same Court of Appeals for the Seventh Circuit in *Kalo Inoculant Co.* v. *Funk Brothers Seed Co.*, 161 F. 2d 981.

There the question presented by the petition was whether a product patent could be sustained for products of nature merely packaged together.

In these two opinions the Court of Appeals has gone from one extreme to the other. In the *Kalo* case, it sustained a patent for the mere discovery that certain bacteria strains, existing in nature, were not mutually inhibitory and hence could be included in a single package; in the instant case, it subtracts from the inventive concept the discovery that the pore size of a manufactured product could be controlled by the temperature of the water used to wash it at a particular stage in the process. In the one case the Court of Appeals sustains a patent for the mere discovery of a law of nature; in the other it ignores that discovery entirely. To sustain this full swing of the judicial pendulum, the Court of Appeals cites the reversing decision of this Court in the *Kalo* case, 333 U. S. 127. The decision of the Court of Appeals, in the eyes of the patent bar, owners of patents, and inventors, will therefore be looked upon as dictated by this Court.

A decision of such momentous consequences in the field of patent law should not be allowed to become final and to carry with it the implication of endorsement by this Court without consideration of the case upon its merits by this Court.

II.

The Decision of the Court of Appeals Is Inconsistent With Decisions of This Court.

This Court has frequently upheld the validity of process patents. In doing so it has recognized that the heart of the invention is the discovery of the scientific principle or law of nature that is the basis of the process. It is there that the Court must look to find the "flash of genius" that justifies a patent. In *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.*, 261 U. S. 45, 68, the discovery was that the rippling of paper stock could be prevented by increasing the initial speed of the stock so that it approximated the speed of the rolls upon which it was fed. This Court said:

> "The invention was not the mere use of a high or substantial pitch to remedy a known source of trouble. I was the discovery of the source not before known and the application of the remedy for which Eibel was entitled to be rewarded in his patent."

Other process cases in which the application of the invention was obvious after the discovery of the scientific principle are:

Tilghman v. *Proctor*, 102 U. S. 707: Hot water and pressure will separate fat acids and glycerine from animal fat.

Providence Rubber Co. v. *Goodyear*, 9 Wall. 788: India rubber can be cured by subjecting it to a high degree of artificial heat.

Carnegie Steel Co. v. *Cambria Iron Co.*, 185 U. S. 403: Substantial uniformity from a plurality of blast furnaces can be maintained by using a common dominant pool.

McClurg v. *Kingsland*, 1 How. 202: The tangential injection of molten metal into a mould gives it a rotary motion and the resulting centrifugal force causes the dross to lie in the center of the casting.

Mowry v. *Whitney*, 14 Wall. 620: Uniform cooling of the thick and thin portions of a railroad wheel can be obtained by reheating the wheels and controlling the rate of cooling.

The Court of Appeals cites *Funk Brothers Seed Co.* v. *Kalo Inoculant Co.*, 333 U. S. 127 and *De Forest Radio Co.* v. *General Electric Co.*, 283 U. S. 664, 685, in support of its theory:

> "He who discovers a hitherto unknown scientific fact or law of nature has no claim to a monopoly of it; if there is to be invention from such a discovery it must come from the application of the law of nature or scientific fact to a new and useful end."

The statement of the Court of Appeals is correct in the sense that patents cannot issue for abstract discoveries of scientific fact. The discovery must be embodied in a process or machine, as it is in the case at bar. But the Court of Appeals departs from the precedents when it goes on to say:

> "The application of the [scientific] law must be novel and inventive in character." (R. 66.)

This does not follow from the *Kalo* and *De Forest* cases. The *Kalo* case did not involve a process patent at all, a fact that is emphasized by this Court, 333 U. S. 127, 136. In that case this Court held that the packaging together of selected strains of several species of bacteria so that the mixture would contain species capable of inoculating different varieties of leguminous plants did not involve invention because there was no interaction between the several species, each of which continued to function individually as though it had been packaged separately.

In the *De Forest* case, the scientific principle which underlay the invention, namely the effect of a high vacuum on the discharge of a vacuum tube had been developed and published by others and the patentee came along with only a means for applying the discovery. It is as though Connolly had disclosed his discovery without applying for a patent and someone else had applied for the patent, merely incorporating Connolly's discovery into a known process.

III.

Conflict With Decisions of Other Courts of Appeals.

The theory of the decision of the Court of Appeals for the Seventh Circuit is opposed to the decisions of the Courts of Appeals for the second and ninth circuits. In *Schering Corp.* v. *Gilbert*, 153 F. 2d 428, 432 (C. A. 2) the Court was considering a patent for a complex chemical product for use in gall bladder radiology. The contention was made that this admittedly new and useful composition of matter was not patentable because the product was a new molecule and any molecule is the inevitable result of the action of so-called laws of nature. In disposing of this contention, the Court of Appeals for the second circuit stated the law exactly contrary to the rule as stated by the Court of Appeals for the Seventh Circuit:

> "If this were wholly true the corollary would be that the process by which a result is reached, involving as it does the application of natural laws, would be likewise unpatentable and that there could be no valid patents for new compositions of matter. Similarly, there could be no valid patents for new machines or for new methods for making them since so-called natural laws of physics, such as those relating to gravity and friction, to mention only two, always play their part. Obviously, such an advanced position cannot be maintained in the face of the patent statute and the multitude of authoritative decisions to the contrary."

In *Vitamin Technologists* v. *Wisconsin Alumni Research Foundation,* 146 F. (2d) 941, 949 (C. A. 9) the invention was based upon the discovery that Vitamin D was added to foods by exposure to the actinic rays of a mercury vapor lamp. As in the case at bar, the statement of the discovery of the scientific principle or law of nature left no room for ingenuity in devising the means to carry it into practice. As pointed out by the Court of Appeals in the case at bar, any scientist, given the benefit of the discovery, could, by trial and error, determine the proper exposure in terms of strength and duration of the rays. The Court sustained the patent saying:

> "Steenbock's claimed inventions include a use of the actinic light rays from the sun or the lamp, but as a part of a process which comprises the preparation of food substances so that all or part of their activatable content will be activated by exposure to such rays. Such process claims no more constitute a claim of monopoly of sunlight, than does the claim of a process patent for the use of a chemically prepared photographing plate or film to be photo chemically activated by light rays constitute a claim of a monopoly of light. As well could it have been said that the claim of the use of the pull of the earth on the weights of the first grandfather's clock constitutes a claim of monopoly of the force of gravity.
>
> "The ultra violet rays of the mercury vapor lamp are natural forces, like such rays in the sun's spectrum, in the sense there are no forces but those of nature of which man is a part. But their use when created by a lamp to activate the antirachitic principle in lipoids processed by exposure to the lamp rays, if not anticipated and properly claimed, is as patentable a process as the use for motor power of electricity created by a dynamo though the electricity so created be identical with that of the lightning of an electric storm."

This Court should resolve the conflict between the Court of Appeals for the Seventh Circuit and the Courts of Appeals for the Second and Ninth Circuits.

Respectfully submitted,

HAROLD W. NORMAN,
Attorney for petitioner.

Office - Supreme Court, U.
FILED
JUN 19 1950
CHARLES ELMORE CROPL
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1949.

No. 105

THE DAVISON CHEMICAL CORPORATION,
Petitioner,

vs.

JOLIET CHEMICALS, INC., DES PLAINES OIL COMPANY, JOLIET CHEMICALS, LTD., and KENNETH F. NASH,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

JULES L. BRADY,
JOHN REX ALLEN,
Counsel for Respondents.

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Chicago 6, Illinois,
Attorneys for Respondents.

The Scheffer Press, Inc.—FInancial 6-2694

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BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1949.

No. 862

THE DAVISON CHEMICAL CORPORATION,
Petitioner,

vs.

JOLIET CHEMICALS, INC., DES PLAINES OIL COMPANY, JOLIET CHEMICALS, LTD., and KENNETH F. NASH,
Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

Plaintiff's petition for writ of certiorari and brief in support thereof are completely without merit. The decision of the Circuit Court of Appeals for the Seventh Circuit is entirely correct, and for the reasons given therein.

Plaintiff's brief and petition fail to mention that the process of the Connolly patent in suit is identical with the process of the prior art Patrick patent, which even disclosed it to be preferable to wash the silica gel in "heated" water (R. 31, lines 84, 85). The Connolly patent in suit merely provided an explanation of the advantages of the heated water wash in controlling pore size; but no new step was added. It may be that this explanation was the result of a discovery, but under the doctrine announced by this Court in *Funk Brothers Seed Co.* v. *Kalo Inoculant Co.*, 333 U. S. 127, it did not entitle the discoverers thereof

to a patent unless as a result thereof a new process utilizing such discovery was also found. This the patentees did not do.

The argument that the present case is in conflict with the decisions of other Courts of Appeal is completely without support. The conflict of decisions doctrine is normally applicable only where conflicting decisions with respect to the same patent have been handed down by different Circuit Courts of Appeal. See *Keller* v. *Adams-Campbell Co.*, 264 U. S. 314, 319. Not only has the patent in suit never been involved in other litigation, but the decisions of the various cases cited are based on different facts, and in no way out of harmony.

The present case involved a patent on the manufacture of silica gel. Petitioner's cited case in the Second Circuit, *Schering Corp.* v. *Gilbert*, 153 F. 2d 428, 432 (this case and one other are the only cases cited by petitioner which were not considered by the Seventh Circuit Court of Appeals) involved a patent on a complex chemical product for use in gall bladder radiology. The Court merely held that the product was new. No process was involved. The other case now first cited (*McClurg* v. *Kingsland*, 1 How. 202) was decided on another point, the question of the presence of invention merely being assumed for the purpose, and not really decided. The Ninth Circuit case, *Vitamin Technologists* v. *Wisconsin Alumni Research Foundation*, 146 F. 2d 941, 949 involved a process for the preparation of food substances so that all or a part of their activatable content would be activated by exposure to actinic rays. In the last mentioned case, the Court brought out that, page 948:

> "a patent whose validity is attacked is anticipated even though the prior patent failed to state and the inventor did not know that his invention brought the process into operation."

In the present case the patent in suit is not only not the same patent as that involved in the other allegedly conflicting cases in other circuits, but is for entirely different subject matter.

In the present case, the defendants have on file a counterclaim for unfair competition (R. 4), the issues of which were divided out and deferred pending determination of the patent issues. In view of the complete absence of any point warranting certiorari, and of any significant new case cited by petitioner, and because of the further delay in proceeding with the counterclaim for unfair competition which will inevitably result if the petition is not acted upon during the present term, it is respectfully requested that a prompt order denying the petition be forthcoming.

Respectfully submitted,

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June 13, 1950.